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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,048	12/19/2000	Achim Storz	PD980044	6809

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EXAMINER

DEMICCO, MATTHEW R

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 02/12/2004

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/720,048

Applicant(s)

STORZ ET AL.

Examiner

Matthew R Demicco

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details. ✓

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS. ✓
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)

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(e) BACKGROUND OF THE INVENTION.

(1) Field of the Invention.

(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.

(f) BRIEF SUMMARY OF THE INVENTION.

(g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

(h) DETAILED DESCRIPTION OF THE INVENTION.

(i) CLAIM OR CLAIMS (commencing on a separate sheet).

(j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

(k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

4. Claims 1 and 2 are objected to because of the following informalities: bullets/dashes should be removed from the claims. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding Claim 1, Applicant claims a method for using the "programme places" of a satellite receiver. The Examiner deems this terminology to be ambiguous as it insufficiently defines the invention. For purposes of examination, "programme places" will be interpreted as "channels."

Regarding Claim 7, Applicant claims a method of supplying a first signal, storing channel information, supplying a second signal and "so on." The Examiner deems this to be vague and indefinite as it insufficiently limits the scope of the invention.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-4 and 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,625,422 to Kim in view of U.S. Patent No. 5,987,213 to Mankovitz et al.

Regarding Claim 1, as best understood by the Examiner, Kim discloses an automatic channel memory device for receiving a broadcast signal via a tuner and storing channel data (Col. 2, Lines 36-46). The receiver is adapted to detect the broadcasting station name of the received channel and store it in memory (Col. 3, lines 1-6) with the channel position information (Col. 3, Lines 9-10). Further disclosed is receiving satellite broadcasting (Col. 6, Lines 5-7). This reads on the claimed method for using the program places of a satellite receiver comprising the step of tuning the receiver to the selected channel, detecting a channel identifying information, determining the channel from the channel information and storing the information about the channel. What is not disclosed, however, is that the satellite receiver is connected to a television receiver and the television receiver supplies a selection signal to the satellite receiver for selecting a

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channel, receives the program signal from the satellite receiver and performs the channel identifying and storing steps. Mankovitz discloses a method for automatically recording television programs wherein a satellite receiver receives commands via an infrared receiver from a television receiver (Col. 32, Lines 22-24). The television receiver sends channel selection commands to the satellite receiver, and the resultant signal is fed to a VCR (Col. 32, Lines 25-28) and to the television. This reads on the claimed supplying of a selection signal from the television receiver to the satellite receiver for selecting a channel on the satellite receiver. Mankovitz is evidence that ordinary workers in the art would recognize the benefits of controlling a satellite receiver from a television receiver. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the television receiver auto-programming method of Kim with the television receiver able to control a satellite receiver of Mankovitz in order to allow a television receiver to select, receive, detect and store received channels and channel data from an external satellite receiver without the need to incur additional manufacturing costs by combining the satellite functionality into the television receiver.

Regarding Claim 2, as best understood by the Examiner, Kim in view of Mankovitz disclose a method as stated above in Claim 1. Kim further discloses a method wherein the user may select a desired channel (Col. 7, Lines 4-9). It is inherent that when a user selects a memorized channel that the stored channel map data will be read and used to tune the receiver. In the method of Kim in view of Mankovitz this would result in tuning of the satellite receiver by the television receiver. This reads on the claimed determining the satellite receiver channel of the selected channel from the stored channel

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information in the television receiver. Mankovitz discloses transferring a signal comprising the satellite receiver channel from the television receiver to the satellite receiver and tuning the satellite receiver to the channel as stated above in Claim 1.

Regarding Claim 3, as best understood by the Examiner, Kim in view of Mankovitz disclose a method as stated above in Claim 2. Kim further discloses a channel map of the scanned/received channels (See Figure 5C). Kim in view of Mankovitz would disclose a channel map of received satellite channels as stated above. This reads on the claimed method wherein the channels of the satellite receiver are assigned to the channels of the television receiver and corresponding information is stored in the television receiver.

Regarding Claim 4, as best understood by the Examiner, Kim in view of Mankovitz disclose a method as stated above in Claim 3. Mankovitz discloses transmitting a selection signal from the television receiver to the satellite receiver as stated above. It is inherent that when the channel selection signal is sent to the satellite receiver that it would switch to the corresponding channel.

Regarding Claim 6, as best understood by the Examiner, Kim in view of Mankovitz disclose a method as stated above in Claim 1. Mankovitz discloses a television signal transferred from the satellite receiver to the television receiver as stated above. Kim further discloses a method wherein the television signal comprises channel-identifying information (Col. 1, Lines 47-51).

Regarding Claim 7, as best understood by the Examiner, Kim in view of Mankovitz disclose a method as stated above in Claim 1. Kim further discloses repeating

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the scanning process repeatedly, iterating over all the channels (Col. 4, Lines 6-8). This reads on the claimed television receiver supplying at first a signal to switch program places and after storing the channel information, supplying a signal to switch to the second channel.

Regarding Claim 8, as best understood by the Examiner, Kim in view of Mankovitz disclose a method as stated above in Claim 1. It is inherent that when a request to change channels is made to a television receiver such as the satellite receiver of Mankovitz that the receiver would perform a search to find the receivable channel.

Regarding Claim 9, as best understood by the Examiner, Kim in view of Mankovitz disclose a method as stated above in Claim 8. What is not disclosed is that a search is automatically started if no signal is received on the first channel. Official Notice is hereby taken that it is well known in the art that a signal receiver may automatically search for a channel with signal if no signal can be found on the present channel. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Kim in view of Mankovitz with the well-known prior art in order prevent the system from tuning to channels that do not exist and consequently confusing the television receiver.

Regarding Claim 10, as best understood by the Examiner, Kim in view of Mankovitz disclose a method as stated above in Claim 1. Kim discloses that the television receiver may be a video recorder (Col. 1, Line 7).

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Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. U.S. Patent No. 5,805,230 to Staron discloses an automatic programming method for a television tuner or video recorder operable to receive extended information in Teletext pages from a satellite source.
- b. U.S. Patent No. 4,876,736 to Kiewit discloses a method for determining a channel's identity and storing the channel reception data. Further, a television receiver re-transmits a control signal in a predetermined format to a second receiver device.
- c. U.S. Patent No. 5,421,031 to De Bey discloses a system for distinguishing received CATV program segments by an identifier.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew R Demicco whose telephone number is (703) 305-8155. The examiner can normally be reached on Mon-Fri, 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MRD

mrd
February 4, 2004


HAI TRAN
PATENT EXAMINER